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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/551,127

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Stephan Haser

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EXAMINER

GEBRESILASSIE, KIBROM K

ART UNIT

PAPER NUMBER

2128

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,127	Applicant(s) HASER ET AL.	
	Examiner KIBROM GEBRESILASSIE	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/26/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amended application filed on 09/24/2009.
2. Claims 3-5 are presented for examinations.

Response to Arguments

3. Applicants provided a copy of each cited foreign patent documents and therefore the IDS is considered.
4. Applicant's amendment/argument relating to Objection to specification, Drawing and Abstract is considered and therefore the rejection is withdrawn.
5. Applicant's amendment relating to 112 rejection is considered. However, note a new 112 rejection for claims 3, and 4.
6. Applicant's arguments/amendment with respect to claim 1 has been considered but are moot in view of the new ground(s) of rejection.

Regarding - 35 USC § 101

7. "Process claims 3-5 were also analyzed under 35 USC 101. It is recognized that, in order to be statutory, a process claim must be 1) tied to a particular machine or apparatus, or 2) it transforms a particular article into a different state or thing. *In re Bilski*, 88 USPQ2d 1385 (2008). It is also recognized that a general purpose computer may be converted into a particular computer through the operation of software on the computer. *In re Alappat*, 31 USPQ2d 1545 (1994). For the instant invention, the specification makes clear that the calculating process is carried out via optimization program operating on a computer (See: PG-PUB, par [0066]). As such, the process is

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ties to a particular machine, thus meeting the *Bilski* test. ". Therefore, claims are **statutory**.

Claim Objections

8. Claim 4 (line 17) is objected to because of the following informalities: the limitation of "the thickness of the lens is correct is adjusted" seems grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 3,

- What does it mean by a "basic design" of claim 3. There is no a clear definition in the specification what "basic design" mean?
- How "starting design" is created from "basic design"? What does "starting design" make it different from "basic design"?
- What does it mean by "wearing test subjects"? What is the difference between "wearing tests" and "wearing test subjects"?
- It recites "wherein each of the basic designs is calculated for a given lens power and for default values for individual parameters". What are the "individual parameters" stands for?

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- It recites “adjusting of the starting design” (line 12). It is unclear what is “adjusted”?

As per Claim 4,

- It recites “equating the starting progressive lens with a progressive lens to be optimized” (line 7). What is the difference between “starting progressive lens” and “progressive lens” to be equated?
- What does it mean by “interpolation and transformation of interpolating and transforming setpoint specification” (line 18)?

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6, 712, 467 issued to Kitani et al in view of US Patent No. 6, 637, 880 issued to Yamakaji et al.

- a. As per Claims 1 and 2, (Canceled).
- b. As per Claims 3, Kitani et al discloses method for calculating an individual progressive lens for a customer, comprising:

creating at least one basic design for lenses based on theoretical specifications, wherein each of the basic designs is calculated for a given lens

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power and for default values for individual parameters (such as "predetermined specific power is determined and design related data is designated as design input, on the basis of this input data, the spherical form of the lens is determined, and the optical characteristics of that lens are computed"; See: Col. 13 lines 13-17);

creating starting designs from the at least one basic design, said starting designs covering a predetermined range of powers of the lens, wherein the starting designs are calculated for the default values of the individual parameters (such as "predetermined specific power is determined and design related data is designated as design input, on the basis of this input data, the spherical form of the lens is determined, and the optical characteristics of that lens are computed"; See: Col. 13 lines 13-17);

calculating individual progressive lenses for wearing tests from the starting designs, corresponding to individual data for wearing test subjects (such as "in optimization, on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form"; See: Col. 13 lines 56-59);

creating final starting designs for production from the adjusted starting designs (such as "processing data is created on the basis of a previously created lens processing program for the progressive power lens"; See: Col. 16 lines 42-; and

calculating individual progressive lens for the customer from the final starting designs according to individual data (such as "in optimization, on the basis of individual design ideas, these design factors are weighted and changed to decide upon the predetermined progressive refractive face form"; See: Col. 13 lines 56-59).

Kitani et al does not expressly disclose adjusting of the starting designs on the basis of the wearing tests.

Yamakaji et al discloses adjusting of the starting designs on the basis of the wearing tests (such as "VC value can be adjusted to a certain prescribed value (for example, a value determined by an optician) (i.e. wearing tests)"; See: Col. 5 lines 51-58).

It would have been obvious to one of ordinary skill in the art to combine the teaching of Yamakaji et al with the teaching of Kitani et al because both references drawn to design process of progressive power lenses. The motivation to include the teaching of Yamakaji et al such as adjusting of the designs on the basis of the wearing tests to the system of Kitani et al would be to determine the conditions of corrective prescriptions.

Allowable Subject Matter

13. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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14. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art on the record, in combination or alone, suggests or discloses the limitations as recited, arranged in claim 4 and as defined in the specification.

15. Further, Claim 5 is objected as being dependent upon claim 4.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIBROM GEBRESILASSIE whose telephone number is (571)272-8571. The examiner can normally be reached on Monday-Friday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571)272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamini S Shah/
Supervisory Patent Examiner, Art
Unit 2128

/KIBROM GEBRESILASSIE/
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